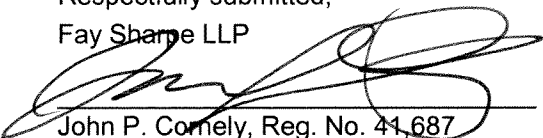



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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket No.: <b>RICZ 2 00009</b>
Application No.: <b>10/758,440</b>		Filed: <b>January 15, 2004</b>
Title: <b>APPARATUS AND METHOD FOR ORGANIZING AND DISPLAYING WALLCOVERING SAMPLES</b>		
First Named Inventor: <b>Butcher, et al.</b>		
Art Unit: <b>3634</b>		Examiner: <b>Colleen M. Quinn</b>
<p>Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). <i>Note: No more than five (5) pages may be provided.</i></p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <p>Respectfully submitted, Fay Sharpe LLP</p> <p>Date: May 5, 2008</p> <p> John P. Cornely, Reg. No. 41,687 1100 Superior Avenue Seventh Floor Cleveland, OH 44114-2579 216-861-5582</p> <p>NOTE: Signature(s) of all the inventor(s) or assignee(s) of record of the entire interest or their representative(s) is/are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<input type="checkbox"/> *Total of        forms are submitted.		
<b>CERTIFICATE OF MAILING OR TRANSMISSION</b>		
<p>I hereby certify that this correspondence (and any item referred to herein as being attached or enclosed) is (are) being</p> <p><input type="checkbox"/> deposited with the United States Postal Service as First Class Mail, addressed to: Mail Stop None, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.</p> <p><input checked="" type="checkbox"/> transmitted to the USPTO by electronic transmission via EFS-Web on the date indicated below.</p>		
Express Mail Label No.:		Signature: 
Date: May 5, 2008		Name: Iris E. Weber

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Office, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S) : Butcher, et al.  
TITLE : **APPARATUS AND METHOD FOR  
ORGANIZING AND DISPLAYING  
WALLCOVERING SAMPLES**  
APPLICATION NO. : 10/758,440  
FILED : January 15, 2004  
CONFIRMATION NO. : 5618  
EXAMINER : Colleen M. Quinn  
ART UNIT : 3634  
LAST OFFICE ACTION : December 5, 2007  
ATTORNEY DOCKET NO. : RICZ 2 00009

**REASONS FOR REQUESTING PRE-APPEAL BRIEF REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Applicants request Pre-Appeal Brief Review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The Applicants respectfully submit the following pages which identify the reasons for requesting Pre-Appeal Brief Review.

### **Summary of the Outstanding Office Action**

**Claims 1, 4-8 and 17-19** stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,104,808 to Day, et al. ("Day").

**Claims 2 and 3** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Day in view of U.S. Patent No. 5,109,991 to McPherson, et al. ("McPherson").

**Claims 9 and 11-14** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Day alone.

**Claim 10** stands rejected under 35 U.S.C. §103(a) as being unpatentable over Day in view of McPherson.

**Claims 15 and 16** stand rejected under 35 U.S.C. §103(a) as being unpatentable over Day in view of U.S. Patent No. 2,786,281 to Kramer, et al. ("Kramer").

### **The Claims Distinguish Patentably Over the Cited Art**

The rejection of claim 1 is clearly improper and should be withdrawn. Day does not anticipate claim 1 at least inasmuch as Day fails to teach all the claimed elements.

For example, claim 1 expressly calls for a plurality of separate sample holders disconnected from one another. The outstanding Office Action alleges that "case **12**" disclosed by Day corresponds to the claimed sample holder. Importantly, however, Day only discloses a single case **12** and not a plurality of separate and disconnected sample holders as claimed. Accordingly, Day cannot be fairly held to anticipate claim 1. Therefore, it is respectfully submitted that the rejection of claim 1 is erroneous and should be withdrawn, and it is furthermore respectfully submitted that claim 1 distinguishes patentably over the art, along with claims 2-8 depending therefrom.

The rejection of claim 9 is also clearly improper and should also be withdrawn. Again, Day does not anticipate claim 9 at least inasmuch as Day fails to teach all the claimed steps.

For example, claim 9 expressly calls for sorting wallcovering samples into a plurality of sets and individually holding each set of samples. Nowhere does Day teach the foregoing. Rather, in direct opposition to the express claim language, Day teaches that all the samples are held together in a single case **12**. Accordingly, claim 9 cannot be fairly held to be obvious in view of Day alone. That is to say, the teachings of Day are directly opposed to the claimed subject matter. Therefore, it is respectfully submitted that the rejection of claim 9 is erroneous and should be withdrawn, and it is furthermore

respectfully submitted that claim 9 distinguishes patentably over the art, along with claims 10-16 depending therefrom.

The rejection of claim 17 is also clearly improper and should also be withdrawn. Again, Day does not anticipate claim 17 at least inasmuch as Day fails to teach all the claimed elements.

For example, claim 17 also expressly calls for a plurality of sample holders into which wallcovering samples are organized such that each holder holds a single distinct set of samples. Contrary to the erroneous allegation in the outstanding Office Action, Day only discloses a single case **12** and not a plurality of sample holders as claimed. Accordingly, Day cannot be fairly held to anticipate claim 17. Therefore, it is respectfully submitted that the rejection of claim 17 is erroneous and should be withdrawn, and it is furthermore respectfully submitted that claim 17 distinguishes patentably over the art, along with claims 18 and 19 depending therefrom.

#### **Rebuttal of Arguments in Outstanding Office Action**

In the "Response to Arguments" section of the outstanding Office Action, it is erroneously alleged that "anyone of ordinary skill in the art would recognize paint as a known wall covering." This allegation is simply false. The word "wallcovering" in the present instance is a term of art. Generally, it is well accepted that "wallcovering" refers to wallpaper and/or other like sheets of material (e.g., vinyl, cloth or otherwise) that may be attached or hung on walls with paste, adhesive or the like to achieve, e.g., an aesthetically pleasing or otherwise desired appearance. Paint is not generally understood or recognized in the art as a "wallcovering." Moreover, it is well accepted practice that the Applicant may be his own lexicographer. In the present case, the meaning of the term "wallcovering" (or more specifically "wallcovering sample") as used in the present application is well established. See, e.g., paragraphs [0002], [0019] and [0020]. Clearly, in light of the generally accepted meaning of the term "wallcovering" in the art and its specific use in the present specification, this term cannot be fairly or reasonably interpreted to include paint as alleged in the outstanding Office Action.

Additionally, in the "Response to Arguments" section of the outstanding Office Action, there also appears to be some suggestion that it was improper to add new claims 17-19 without cancelling a corresponding number of pre-existing claims. Applicant is aware of no such requirement that must be adhered to when responding to

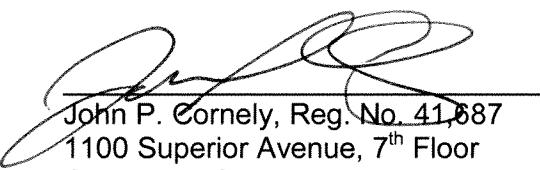
a non-final Office Action as was the case in the present instance. Should the Examiner continue or seek to impose such a requirement, it is respectfully request that the legal authority or other suitable basis for making such a requirement be expressly stated on the record. Absent a legal authority or other legitimate basis to the contrary, the Applicant can see no reason why they should not be allowed to add new claims in response to a non-final Office Action in the manner they had.

### **Conclusion**

For at least the reasons identified above, it is respectfully submitted that the final rejection of claims 1-19 is clearly erroneous. Accordingly, the rejection should be withdrawn and prosecution of the present application reopened. Moreover, it is respectfully submitted that claim 1-19 in fact distinguish patentably over the prior art, and an early indication of the same is therefore earnestly solicited.

Respectfully submitted,  
FAY SHARPE LLP

May 5, 2008  
Date



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